

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM G. HERBERT, LOREN E. HENDRIX,
GARY J. MAIER and ERNEST F. MATYI

Appeal No. 95-2930
Application No. 08/043,953¹

ON BRIEF

Before SOFOCLEOUS, CAROFF and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

Herbert et al. (appellants) appeal from the examiner's final rejection of claims 37 through 45 which are all of the claims remaining in the application.

Claim 37 is representative of the subject matter on appeal and reads as follows:

¹ Application for patent filed April 5, 1993.

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37. A process comprising:

(a) forming an article on a mandrel comprised of a contoured surface, wherein the article overlays the contoured surface of the mandrel, thereby resulting in the article comprised of a corresponding contoured surface, wherein the contoured surface of the mandrel defines:

(i) two opposed planes, at least one of which is inclined;

(ii) a first flat region curving into a first raised region and a second flat region curving into a second raised region;

(iii) a screw thread; or

(iv) one or more grooves; and

(b) subjecting the article to circumferential motion relative to the mandrel, wherein moving the corresponding contoured surface of the article over the contoured surface of the mandrel creates axial movement of the article away from the mandrel.

The sole reference relied upon by the examiner is:

Haidle et al. (Haidle)	4,909,582	Mar. 20,
1990		

Claims 37 through 45 stand rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of Haidle.

We reverse.

In rejecting the claims under 35 U.S.C. § 103, the examiner recognizes that the Haidle reference does not describe:

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(b) subjecting the article to circumferential motion relative to the mandrel, wherein moving the article over the contoured surface creates axial movement of the article away from the mandrel.

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Specifically, the examiner states (Answer, page 3) that:

The Haidle patent accomplishes the removal of the article by moving the mandrel and article, not just the article as presently claimed.

The examiner then goes on to conclude (Answer, page 3) that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize any of the conventional circumferential movements to remove the article from the mandrel, because the Haidle patent discloses the electroforming of an article on a mandrel and the removal of the article by a functionally equivalent circumferential movement.

However, the examiner's conclusion is unsupported by facts.

On this record, the examiner has not explained how waveguide 26 (article) can be rotated with respect to a stationary mandrel so as to create an axial movement of the waveguide 26. The examiner also has not explained why one of ordinary skill in the art would have been motivated to employ the device of the type described in the Haidle reference in the manner proposed by the examiner. The examiner simply has not carried his or her burden of establishing a prima facie case of obviousness within the meaning of 35 U.S.C.

§ 103.

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As a final point, we note that U.S. Patent No. 4,781,799 issued to Herbert, Jr. et al. on November 1, 1988 (Herbert) describes removing an electroformed hollow article (sleeve) from a mandrel by sliding the article away from the mandrel. See column 20, lines 35-47 and column 22, lines 22-39. Upon return of this application, the examiner is advised to determine whether the Herbert reference affects the patentability of the claimed subject matter. That is, the examiner is advised to determine whether sliding the article necessarily involves twisting (circumferential movement) and pulling the article or whether one of ordinary skill in the art would have reasonably expected that twisting and pulling would have enhanced the sliding of the article away from the mandrel.

In view of the foregoing, we reverse the examiner's decision rejecting the appealed claims under 35 U.S.C. § 103 and remand

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the application to the examiner to determine whether the
Herbert reference affects the patentability of the claimed
subject matter.

REVERSE and REMAND

MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MARC L. CAROFF)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CHUNG K. PAK)	
Administrative Patent Judge)	

jrg

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Application No. 08/043,953

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Appeal No. 95-2930
Application No. 08/043,953

JENINE GILLIS

Appeal No. 95-2930

Serial No. 08/043,953

Judge PAK

Judge SOFOCLEOUS

Judge CAROFF

Received: 1/6/99

Typed: 1/12/99

DECISION: REVERSE/REMAND

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1102

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

Mailed:

Updated Monthly Disk (FOIA): _____

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